

REMARKS

In response to the Office Action mailed February 2, 2009 (hereinafter, "the Office Action"), the response for which is due May 2, 2009, Applicants respectfully request reconsideration and reexamination of this application, removal of the rejections outlined below, and the timely allowance of the pending claims.

Status and Disposition of the Claims

Following the Office Action, claims 1-30 stand rejected. Claims 1, 12, and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0193671 A1 to Ciurczak et al. ("Ciurczak"). Claims 25, 27, 29, and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2005/0002483 A1 to Wilcox ("Wilcox"). Claims 2, 4-7, 13, and 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of U.S. Patent No. 6,306,104 to Cunningham et al. ("Cunningham"). Claims 3, 15, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of Official Notice. Claims 8-11 and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of Wilcox. Claims 26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilcox in view of Official Notice. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ciurczak in view of Official Notice further in view of Cunningham.

Claims 1-30 remain pending for examination.

Rejection of Claims Under 35 U.S.C. § 102(b)

Rejection of Claim 1

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Ciurczak. Applicants respectfully traverse this § 102(b) rejection, and respectfully request withdrawal of the rejection for at least the following reasons.

To anticipate a claim, the reference must disclose "all of the limitations arranged or combined in the same way as recited in the claim." *Net Money!N Inc. v. VeriSign Inc.*, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008). In the present application, independent claim 1 recites the following:

1. (Original) A method of using a medical diagnostic testing device, said method comprising:

obtaining a test result using said medical diagnostic testing device;

storing said test result in said medical diagnostic testing device; and

recording a voice message, associated with said test result, in said medical diagnostic test device.

However, Applicants respectfully submit that nowhere does Ciurczak disclose all of the limitations arranged or combined in the same way as recited in claim 1 for at least the following reasons.

First, Ciurczak does not disclose storing a test result in a medical diagnostic testing device, as recited in claim 1. Ciurczak is directed to a system for generating and utilizing individualized modeling equations for predicting a patient's blood glucose values using a central computer. See Ciurczak at Abstract. In the Ciurczak system, "a noninvasive spectral scan [is] obtained from a remote spectral device... and sent to a central computer." *Id.* at ¶ [0030] (emphasis added). "[The] central computer stores the

generated spectral scan... [and a] resultant blood glucose level is calculated[.]” *Id.* (emphasis added). Thus, Ciurczak discloses obtaining a test result using a remote testing device and then storing the result in a central computer, not in the testing device. Nowhere does Ciurczak disclose storing a test result in a medical diagnostic testing device.

Further, as the remote spectral device and the central computer of Ciurczak are separate and not included in a single device, storing the results of a spectral scan in the central computer does not imply storage within the spectral device. Ciurczak explains that “[t]he remote spectral device communicates with the central computer by any conventional mode of data transmission, such as a cellular data link, a telephone modem, a direct satellite link, or an Internet link.” *Id.* at ¶ [0032]. It is evident from this description of the communication between the remote spectral device and the central computer that they are distinct and physically separated. Accordingly, Ciurczak’s disclosure of storing data in the central computer described therein does not even implicitly involve storing data within a diagnostic testing device. Therefore, it is respectfully submitted that Ciurczak does not anticipate claim 1, since Ciurczak fails to disclose, teach, or suggest obtaining a test result using a medical diagnostic testing device and storing the test result in the device.

Second, claim 1 further recites “recording a voice message, associated with said test result, in said medical diagnostic test device[.]” but nowhere does Ciurczak disclose recording a voice message in a medical diagnostic test device. The Examiner contends that this limitation is anticipated by Ciurczak’s disclosure of using “a voice recognition feature... as a transmission mechanism between a diabetic patient and a doctor.”

Office Action at p. 3. However, the Examiner has provided no tenable explanation as to how using voice recognition as a "transmission mechanism," as disclosed in Ciurczak, is equivalent to recording a voice message. Furthermore, even if the use of voice recognition as disclosed in Ciurczak did involve recording, nowhere does Ciurczak disclose, teach, or suggest that such recording would be in a medical diagnostic test device, as opposed to, for example, the central computer of Ciurczak. Thus, it is respectfully submitted that Ciurczak does not anticipate claim 1, since Ciurczak fails to disclose, teach, or suggest recording a voice message in a medical diagnostic test device.

Because Ciurczak fails to disclose, teach, or suggest obtaining a test result using a medical diagnostic testing device and storing it in the device, as well as recording a voice message associated with the test result in the device, it is respectfully submitted that claim 1 is patentable over Ciurczak, and that the § 102(b) rejection of this claim should be withdrawn.

Rejection of Claims 12 and 14

Claims 12 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ciurczak. Applicants respectfully traverse these § 102(b) rejections, and respectfully request withdrawal of the rejections for at least the following reasons.

Claim 12 of the present application recites, "A medical diagnostic testing device, comprising: a testing system for obtaining a test result; a memory for storing said test result; and an audio system for recording a voice message associated with said test result." Applicants respectfully submit that nowhere does Ciurczak disclose all of the

limitations arranged or combined in the same way as recited in claim 12 for at least the following reasons.

First, Ciurczak does not disclose a medical diagnostic testing device that has a memory for storing test results. As discussed above, the remote testing devices described in Ciurczak transmit acquired test results to a central computer described therein for storage. See Ciurczak ¶ [0030]. Nowhere does Ciurczak even suggest that the remote testing devices contain memory, or any other means, for storing test results in the device. Therefore, it is respectfully submitted that Ciurczak does not anticipate claim 12, since Ciurczak fails to disclose, teach, or suggest a medical diagnostic testing device having memory for storing test results in the device.

Second, Ciurczak does not disclose a medical diagnostic testing device that has an audio system for recording a voice message. As discussed above, nowhere does Ciurczak disclose an audio system for recording a voice message, let alone an audio system for recording a voice message incorporated in a medical diagnostic testing device. Consequently, it is respectfully submitted that Ciurczak cannot anticipate claim 12 as it fails to disclose, teach, or suggest a medical diagnostic testing device that has an audio system for recording a voice message, as claimed.

Because Ciurczak fails to disclose, teach, or suggest a medical diagnostic testing device having a memory for storing test results and an audio system for recording a voice message, it is respectfully submitted that claim 12 is patentable over Ciurczak, and that the § 102(b) rejection of this claim should be withdrawn. Further, because claim 14 depends from claim 12, it is respectfully submitted that claim 14 is allowable for

at least the same reasons as claim 12, and that the §102(b) rejection of claim 14 should also be withdrawn.

Rejection of Claims 25, 27, 29, and 30

Claims 25, 27, 29, and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wilcox. Applicants respectfully traverse these § 102(b) rejections, and respectfully request withdrawal of the rejections for at least the following reasons.

Claim 25 recites, “In a medical diagnostic testing device that obtains and stores test results, the improvement comprising: an audio system for recording a voice message associated with a test result.” Applicants respectfully submit that Wilcox cannot anticipate claim 25 because Wilcox does not disclose a medical diagnostic testing device having an audio system for recording a voice message.

Wilcox merely discloses the use of standard voice recognition software on a computer as a means for a medical professional to input information into the computer. Wilcox is generally directed to methods and apparatuses for outsourcing professional radiology interpretation to ensure high quality service, particularly after normal business hours at the site where the radiology study is obtained. See Wilcox ¶ [0001]. Nowhere does Wilcox specifically disclose an audio system for recording a voice message, let alone such a system incorporated in a medical diagnostic testing device.¹ Wilcox does

¹ The Examiner cites “¶[0101]” in asserting Wilcox discloses the limitations of claim 25. Office Action at p. 4. However, Wilcox does not contain a ¶ [0101]. It appears the Examiner may have been pointing to ¶ [0101] of Ciurczak, as was cited elsewhere in the Office Action, but nowhere does the Office Action state that claim 25 is rejected as being anticipated by Wilcox. However, in the interest of expediting prosecution, Applicants respectfully submit that claim 25 is not anticipated by Ciurczak at least

(continued...)

discuss using voice recognition, but only in disclosing that "[a]fter the interpretation of [a particular radiology] study is completed a formal report is created using industry standard computer based voice recognition software." Wilcox at ¶ [0009] (emphasis added). Disclosure of using industry standard voice recognition software on a computer is different, on its face, from a medical diagnostic testing device having an audio system for recording a voice message, and the Examiner has provided no tenable argument to the contrary. Therefore, Wilcox does not anticipate claim 25 as it fails to disclose, teach, or suggest a medical diagnostic testing device that has an audio system for recording a voice message, as claimed. Further, because claims 27, 29, and 30 depend from claim 25, it is respectfully submitted that claims 27, 29, and 30 are allowable for at least the same reasons as claim 25, and that the §102(b) rejections of claims 27, 29, and 30 should also be withdrawn.

Rejection of Claims Under 35 U.S.C. § 103(a)

Under 35 U.S.C. § 103(a), claims 2, 4-7, 13, and 17-19 are rejected as being unpatentable over Ciurczak in view of Cunningham, claims 3, 15, 20, and 21 are rejected as being unpatentable over Ciurczak in view of Official Notice, claims 8-11 and 22-24 are rejected as being unpatentable over Ciurczak in view of Wilcox, claims 26 and 28 are rejected as being unpatentable over Wilcox in view of Official Notice, and

(...continued)

because Ciurczak fails to disclose, teach, or suggest a medical diagnostic testing device having an audio system for recording a voice message, as discussed above with respect to claim 12.

claim 16 is rejected as unpatentable over Ciurczak in view of Official Notice further in view of Cunningham. Applicants respectfully traverse these § 103(a) rejections.

Claims 2-11 all depend from claim 1. For at least the reasons noted above with regard to claim 1, none of the above cited references, alone or in the respective combinations, discloses, teaches, or suggests each and every element of claim 1.

Claims 13 and 15-24 all depend from claim 12. For at least the reasons noted above with regard to claim 12, none of the above cited references, alone or in the respective combinations, discloses, teaches, or suggests each and every element of claim 12.

Finally, claims 26 and 28 depend from claim 25. For at least the reasons noted above with regard to claim 25, none of the above cited references, alone or in the respective combinations, discloses, teaches, or suggests each and every element of claim 25.

Thus, it is respectfully submitted that claims 2-11, 13, 15-24, 26, and 28 are patentable over the respectively cited references, and that the § 103(a) rejections of these claims should be withdrawn. Applicants respectfully request reconsideration and allowance of claims 2-11, 13, 15-24, 26, and 28.

Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification,

abstract, or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 1, 2009

By: _____


Nicholas S. Stroeher
Reg. No. 62,926
(617) 452-1647